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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,897	04/12/2001	Kenichi Ueyama	205733US0	1680

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/832,897

Applicant(s)

UEYAMA ET AL.

Examiner

Sharmila S. Gollamudi

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**—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —**

THE REPLY FILED 27 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

T.D

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Applicant arguments are essentially the same as those presented on 2/4/05. Applicant argues the “consisting essentially” language as limiting the scope to what materially affects the basic and novel characteristics of the composition. Applicant argues that “at the heart of the examiner's position appears to be the erroneous belief that the basic and novel characteristics of a composition must necessarily be altered by the majority, by weight, components. There is no requirement that a claim, which recites “consisting essentially”, define a majority by weight of the components. To the contrary, such a claim is interpreted based on the presence or absence of components, which would affect the basic and novel characteristics of the composition.

Applicant's arguments have been fully considered but they are not persuasive. Again the examiner is aware of the definition of “consisting essentially of” and hence the examiner has rejected the claims under indefiniteness. The examiner understands that the claim is interpreted based on the presence or absence of components, which would affect the basic and novel characteristics of the composition; however applicant's claims are ambiguous as to what is considered to materially and basically affect the composition. In essence, it is unclear what is being excluded. Moreover, a skilled artisan would not know the metes and bounds of the claim language since the dependent claims are inconsistent with the independent claim.

Again the examiner provides a detailed reasoning. The critical components of the claims is A) 0.5-25% oil, B) 0-15% water, and a solvent. Hence, the majority of the composition must be the solvent and oil. However, the dependent claims are inconsistent with the scope of the independent claims. For instance, claim 12 is directed to a composition wherein **both** the oil agent and the solvent can have a minimum weight percent of **5.5**. Therefore, if the composition had 5.5% of both an oil agent and solvent, and 0% water as claimed in the parent claim, the

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composition would have 5.5% of the critical components. Therefore, 94.5% of the composition contains *unknown* components; thus rendering a markedly different composition than the “basic and novel” composition claimed in the independent claim. The examiner notes that applicant has repeatedly attempted to exclude various additives and excipients contained in the prior art compositions by using the instant claim language, however clearly the applicant is using the claim language in attempt to get around the prior art and at the same time ensure a broad scope without clearly excluding any component(s). Accordingly, the rejection is maintained.

The examiner notes that arguments made with regard to Matsunaga, Komori, and Nanba; however since these are the same arguments made by the applicant prior to the Final Office Action. The examiner has addressed all of these arguments in detail in the Final Office Action and maintains her position for the reasons set forth in the Final Office Action of 5/12/05.

The examiner addresses the arguments pertaining to Ona since Ona was newly cited prior art (necessitated by the amendment). Applicant argues Ona fails to disclose a method of conditioning the hair wherein the composition is applied to dry hair, allowed to stand for 3-120 minutes, and then washed away.

Applicant's arguments filed have been fully considered but they are not persuasive. The examiner points out to example 2, which reads on the instant method claim. Example 2 discloses a composition containing 4 parts of organopolysilioxane (oil agent) and 96 parts of n-pentane (solvent). Hair is immersed in the composition and **after 30 minutes**, the hair is dried with a hair dryer. The lock of hair is then washed with soap. Ona teaches the hair grooming composition provides glossiness, suppleness, **smoothness**, and **moist feeling**, which clearly reads on a method of “conditioning the hair”. The examiner points out that the instant specification does not

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expressly state that the instant invention is directed to conditioning the hair, however the instant disclosure teaches the composition provides for a improved feel that is defined as a **smoothness**, free from stickiness, and **moist feel**. Therefore, although the applicant does not expressly have support for “conditioning the hair”, it was the examiner’s position that the disclosure of “moist feel and smoothness” provides for implicit support for applicant’s methodology of conditioning the hair. Therefore, Ona’s composition, which provides smooth and a moist feel is also implicit for conditioning the hair. If applicant asserts that the teaching of smooth feel, tangle free, etc. are not implicit for conditioning the hair, the examiner will have to reconsider her position on applicant’s support for “conditioning the hair.” Thus, the rejection is maintained.

#### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

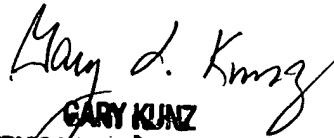
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Sharmila S. Gollamudi  
Examiner  
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SSG

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**